



The Court of Justice specifies the criteria governing revocation of .eu top level domain names which have been registered in a speculative or abusive manner

In assessing whether a domain name has been registered in bad faith, all the relevant factors specific to the particular case must be taken into consideration.

Registration of .eu top level domain names, managed by EURid, the European Registry for Internet Domains, based in Brussels, began on 7 December 2005. Registration takes place in three successive phases and each phase is governed by the first-come first-served principle. During the first two phases, called the 'sunrise period', registration was reserved exclusively to holders of prior rights and public bodies, with the first phase being reserved, in particular, to the holders of registered national and Community trade marks. A domain name registered in a speculative or abusive manner, in particular where it is registered in bad faith, may be revoked following an extra-judicial or, where appropriate, judicial procedure.

Internetportal und Marketing, an Austrian undertaking, obtained registration, during the first phase of the sunrise period, of the domain name 'www.reifen.eu' on the basis of its trade mark &R&E&I&F&E&N&, which it had previously had registered in Sweden for safety belts. However, the undertaking in question did not have any intention of using the &R&E&I&F&E&N& trade mark for the goods in respect of which it had had the mark registered. On the contrary, it intended to operate an internet portal for trading in tyres, corresponding to the domain name thus registered (the word 'Reifen' means 'tyres' in German). In order to be able to register the desired domain name, namely 'www.reifen.eu', during the first phase of registration, it eliminated the special character '&' from its Swedish trade mark &R&E&I&F&E&N&, applying one of the transcription rules laid down in the rules of Community law¹ governing such special characters. Since such special characters cannot appear in a domain name by reason of technical constraints, those rules provide for, inter alia, their elimination. In addition, Internetportal und Marketing had 33 generic terms registered as trade marks in Sweden, each incorporating the special character '&' before and after each letter. That undertaking also submitted applications for the registration of 180 domain names consisting of generic terms.

In proceedings brought by the holder of the Benelux trade mark 'Reifen', registered for, inter alia, window cleaning products, the Arbitration Court attached to the Economic Chamber and Agricultural Chamber of the Czech Republic, which has jurisdiction in alternative-dispute-resolution proceedings concerning .eu top level domain names, formed the view that Internetportal und Marketing had acted in bad faith. It accordingly withdrew the domain name in question from that undertaking and transferred it to the holder of the 'Reifen' trade mark. The Oberster Gerichtshof (Austrian Supreme Court), which, as the court of final instance, must resolve the dispute, has referred several questions to the Court of Justice for a preliminary ruling.

In its judgment, delivered today, the Court states, first, that bad faith can be established by circumstances other than those expressly listed in the Community rules, since the list that appears there is not exhaustive. Secondly, the Court points out that, in order to assess whether there is

¹ Commission Regulation (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration (OJ 2004 L 162, p. 40).

conduct in bad faith, all the relevant factors specific to the particular case must be taken into consideration, in particular the circumstances in which registration of the trade mark forming the basis for registration of the domain name at issue during the first phase was obtained and the circumstances in which the .eu top level domain name itself was registered.

With regard to the circumstances in which registration of the trade mark in issue was obtained, consideration must be given, in particular, to: 1. the intention not to use the trade mark in the market for which protection was sought; 2. the unusual and, from a semantic and visual point of view, linguistically irrational presentation of the trade mark; 3. the fact of having registered a large number of other trade marks corresponding to generic terms; and 4. the fact of having registered the trade mark shortly before the beginning of phased registration of .eu top level domain names.

With regard to the conditions in which the .eu top level domain name was registered, consideration must be given, in particular, to: 1. the abusive use of special characters or punctuation marks for the purposes of applying the transcription rules laid down in the Community rules; 2. registration during the first phase of the phased registration on the basis of a trade mark acquired in circumstances such as those set out above; and 3. the fact of having applied for registration of a large number of domain names corresponding to generic terms.

Finally, the Court pointed out that, had Internetportal und Marketing not employed the stratagem of a trade mark created and registered solely for the purpose of registering a desired domain name during the first registration phase, it would have had to wait until the general opening of registration of .eu top level domain names, thereby running the risk, just like any other person interested in the same domain name, of being pre-empted, in accordance with the first-come first-served principle, by another application for registration lodged in advance of its own application. Such conduct is manifestly intended to circumvent the procedure for phased registration.

NOTE: A reference for a preliminary ruling allows the courts and tribunals of the Member States, in disputes which have been brought before them, to refer questions to the Court of Justice on the interpretation of European Union law or the validity of a European Union act. The Court of Justice does not decide the dispute itself. It is for the national court or tribunal to dispose of the case in accordance with the Court's decision, which is similarly binding on other national courts or tribunals before which a similar issue is raised.

Unofficial document for media use, not binding on the Court of Justice.

The [full text](#) of the judgment is published on the CURIA website on the day of delivery.

Press contact: Christopher Fretwell ☎ (+352) 4303 3355